

## 2.146 Petition to the Director

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	76365484
<b>REGISTRATION NUMBER</b>	2715307
<b>MARK SECTION</b>	
<b>MARK</b>	YOSEMITE NATIONAL PARK
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ATTACHMENT(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">PetitionDirector-Reconsider-Suspension_20165100623532.pdf</a>
<b>CONVERTED PDF FILE(S) (11 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\763\654\76365484\xml3\PDR0002.jpg</a>
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<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>FEE PER CLASS</b>	100
<b>TOTAL FEES DUE</b>	100
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/Scott Bolden/
<b>SIGNATORY'S NAME</b>	Scott Bolden
<b>SIGNATORY'S POSITION</b>	Attorney of Record, DC bar member
<b>SIGNATORY'S PHONE NUMBER</b>	202-307-0262
<b>DATE SIGNED</b>	06/10/2016

<b>SUBMISSION SIGNATURE</b>	/Scott Bolden/
<b>SIGNATORY'S NAME</b>	Scott Bolden
<b>SIGNATORY'S POSITION</b>	Attorney of Record, DC bar member
<b>SIGNATORY'S PHONE NUMBER</b>	202-307-0262
<b>DATE SIGNED</b>	06/10/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Jun 10 12:16:33 EDT 2016
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## 2.146 Petition to the Director

### To the Commissioner for Trademarks:

The following is submitted for registration number. **2715307** YOSEMITE NATIONAL PARK

### FORM INFORMATION

#### Original PDF file:

[PetitionDirector-Reconsider-Suspension\\_20165100623532.pdf](#)

#### Converted PDF file(s) (11 pages)

[Attachments-1](#)

[Attachments-2](#)

[Attachments-3](#)

[Attachments-4](#)

[Attachments-5](#)

[Attachments-6](#)

[Attachments-7](#)

[Attachments-8](#)

[Attachments-9](#)

[Attachments-10](#)

[Attachments-11](#)

#### FEE(S)

Fee(s) in the amount of \$100 is being submitted.

#### SIGNATURE(S)

##### Declaration Signature

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application, submission, or any registration resulting therefrom, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature: /Scott Bolden/ Date: 06/10/2016  
Signatory's Name: Scott Bolden  
Signatory's Position: Attorney of Record, DC bar member  
Signatory's Phone Number: 202-307-0262

**Submission Signature**

Signature: /Scott Bolden/ Date: 06/10/2016  
Signatory's Name: Scott Bolden  
Signatory's Position: Attorney of Record, DC bar member  
Signatory's Phone Number: 202-307-0262

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the petitioner's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the petitioner in this matter: (1) the petitioner has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the petitioner has filed a power of attorney appointing him/her in this matter; or (4) the petitioner's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 9356  
RAM Accounting Date: 06/10/2016

Serial Number: 76365484  
Internet Transmission Date: Fri Jun 10 12:16:33 EDT 2016  
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6-20160610120517489315

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
ON PETITION TO THE DIRECTOR

UNITED STATES DEPARTMENT OF THE  
INTERIOR, NATIONAL PARK SERVICE,

Petitioner,

v.

DNC PARKS & RESORTS AT YOSEMITE,  
INC.,

Respondent.

Petition to the Director

Relating to:  
Cancellation No. 92063225

**THE NATIONAL PARK SERVICE’S PETITION TO THE DIRECTOR TO REVERSE  
THE MAY 18, 2016 ORDER OF THE TRADEMARK TRIAL AND APPEAL BOARD**

Petitioner, the National Park Service (“the NPS”), hereby petitions the Director of the United States Patent and Trademark Office (“Director”) to reverse an interlocutory order issued by the Trademark Trial and Appeal Board (“TTAB” or “the Board”) in Cancellation No. 92063225 granting Respondent’s motion to suspend. The Director should reverse the Board’s suspension because the Board abused its discretion in concluding that a pending breach-of-contract suit in the United States Court of Federal Claims may have a bearing on the cancellation proceeding. In particular, the Board’s conclusion that “the [Court of Federal Claims] may consider and even reach a determination of ownership rights in the marks at issue” is manifestly flawed because it failed to consider the subject matter expertise of the Board, the unique jurisdictional limits of the United States Court of Federal Claims, and the treatment of incontestable registrations under the Lanham Act.



## STATEMENT OF FACTS

### **Background**

The present dispute before the Board is an essential part of a larger dispute between the NPS and DNC Parks & Resorts at Yosemite, Inc. (“DNCY”) regarding the validity and fair value of trademarks registered by DNCY, a former concessioner at Yosemite National Park.

On September 17, 2015, DNCY filed suit against the United States in the United States Court of Federal Claims. See DNC Parks & Resorts at Yosemite, Inc. v. United States, Court of Federal Claims No. 15-1034 C. DNCY asserted<sup>1</sup> that it was entitled to more than \$40 million in compensation for a portfolio of trademarks that it created or acquired in connection with its concessioner operations at Yosemite National Park. During its service as the NPS’s concessioner at Yosemite National Park, DNCY obtained incontestable trademark registrations to the following iconic names:

- YOSEMITE NATIONAL PARK, Registration No. 2715307;
- THE AHWAHNEE, Registration No. 2772512;
- THE AHWAHNEE, Registration No. 1529066;
- CURRY VILLAGE, Registration No. 2685968;
- WAWONA, Registration No. 2739708;
- BADGER PASS, Registration No. 2720778; and
- BADGER PASS, Registration No. 3731325 (collectively, “the Subject Registrations”).

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<sup>1</sup> DNCY attached its First Amended Complaint from the Court of Federal Claims to its Motion to Suspend. See Motion to Suspend Att. A (TTABVUE # 6). The NPS has attached its Answer to DNCY’s First Amended Complaint to this Response in Opposition. See Response Ex. A (TTABVUE # 9). These respective pleadings are cited to as “Complaint” and “Answer” herein.

DNCY did not specifically identify these registrations in its Complaint, and it did not directly allege the validity of its asserted trademarks.<sup>2</sup> On February 11, 2016, the United States filed its Answer to DNCY's Amended Complaint. On February 26, 2016, the NPS initiated the Board proceeding by filing its Petition for Cancellation with the Board. See Petition to Cancel (TTABVUE # 1).

### **The Motion to Suspend**

On March 14, 2016, DNCY filed a motion to suspend the cancellation proceeding pursuant to 37 U.S.C. § 2.117(a). See Motion to Suspend (TTABVUE # 6). DNCY asserted that the litigation in the Court of Federal Claims would moot the Board proceeding. See id. at 5-6.

On March 31, 2016, the NPS responded in opposition to DNCY's motion. See Response (TTABVUE # 9). The NPS countered that the litigation in the Court of Federal Claims could not moot the Board proceeding because DNCY ignored a gateway issue – whether its asserted registrations were valid throughout the time period it claimed for valuation purposes. See id. at 5. The NPS also explained that DNCY ignored important precedent with respect to key limitations on the jurisdiction of the Court of Federal Claims. See id. at 9-12. The NPS pointed out that, unlike the situation with a federal district court, the respective jurisdictions of the Board and the Court of Federal Claims were separate and complementary, rather than overlapping. See id. at 11. DNCY filed its reply on April 18, 2016. See Reply (TTABVUE # 10). DNCY did not address the NPS's jurisdictional arguments.

On May 18, 2016, the Board granted DNCY's motion to suspend the cancellation proceeding pursuant to 37 U.S.C. § 2.117(a). (TTABVUE Doc. # 14). The Board made two

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<sup>2</sup> Upon information and belief, DNCY asserts that it is owed compensation for more than 30 registered trademarks, yet it specifically identified only a single registration, see Complaint ¶ 13 (TTABVUE # 6 Att. A), and attached no registration documents to its Complaint.

findings of fact in its order. First, the Board noted that “[t]he civil action involves the same parties and the same marks at issue in this proceeding.” Id. at 2. Second, the Board noted that “[t]he civil action involves claims by DNC regarding an alleged breach of contract by NPS and seeks to establish the fair market value of registered trademarks at issue in this Board proceeding.” Id. at 2. Both of these facts had been identified by the parties to the cancellation proceeding, and neither was contested.

After reciting the undisputed facts, the Board announced its reasoning and ultimate conclusion:

In considering the contract alleged to have been breached and whether it has been breached, the [Court of Federal Claims] may consider and even reach a determination of ownership rights in the marks at issue. In view thereof, the civil action may be dispositive of or have a bearing on this proceeding.

Id. at 2. The Board cited no other facts in support of its conclusion that the Court of Federal Claims “may consider and even reach a determination of ownership rights in the marks at issue.”

Id. The Board cited no legal authority in support of its conclusion. See id. The Court of Federal Claims, upon receipt of the Board’s order suspending the cancellation proceeding, denied a motion to stay filed by the United States in that case. See May 19, 2016 Order (ECF # 30).

The facts identified above are drawn directly from the cited documents of record and do not require any further proof on petition.

## **POINT TO BE REVIEWED BY THE DIRECTOR**

Pursuant to 37 C.F.R. § 2.117(a), the Board may suspend the proceedings in light of “a civil action . . . which may have a bearing on the case.” The Federal Circuit and its predecessors have held, however, that the United States Court of Federal Claims is jurisdictionally barred from hearing a trademark infringement suit, a review of the Board, and a plaintiff’s claim against the United States for trademark cancellation. Here, the following issue is presented for review:

Whether the Board abused its discretion in reasoning that the Court of Federal Claims “may consider and even reach a determination of ownership rights” without considering the subject matter expertise of the Board, the jurisdictional limitations of the Court of Federal Claims, and the statutory legal presumptions provided to incontestable registrations.

## **ARGUMENT**

### **I. STANDARD OF REVIEW**

Pursuant to 35 U.S.C. § 2 and 37 C.F.R. § 2.146(a)(3), the Director may invoke supervisory authority in appropriate circumstances. In an *inter partes* proceeding, a party may petition the Director to review an interlocutory order of the TTAB. See TBMP §§ 901.02(a), 905; TMEP §§ 1703, 1704. The Director, however, will reverse an interlocutory order of the TTAB only if there is clear error or abuse of discretion. See Kimberly Clark Corp. v. Paper Converting Indus. Inc., 21 USPQ2d 1875, 1877 (Comm’r Pats. 1991); Riko Enters., Inc. v. Lindsley, 198 USPQ 480, 482 (Comm’r Pats. 1977); TMEP § 1703.

As stated in the Board’s Manual of Procedure, “[s]uspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board.” See TBMP § 510.02(a). The Board may suspend the proceedings in light of “a civil

action or another Board proceeding which may have a bearing on the case.” 37 C.F.R. § 2.117(a). A tribunal’s discretion in suspending its proceedings, however, is not unbounded. See, e.g., Cherokee Nation of Okla. v. United States, 124 F.3d 1413, 1416 (Fed. Cir. 1997). In particular, the Director has typically examined whether the Board identified sound reasons in support of its conclusion that the civil action could bear on the Board’s proceeding. See J & G Grant v. Sven Brassat, 2013 WL 11247282 (USPTO Dir. 2013); Community Trust Bancorp, Inc. v. Community Trust Bank, 2012 WL 12517285 (USPTO Dir. 2012).

## **II. THE BOARD FAILED TO CONSIDER THE LIMITED JURISDICTION OF THE COURT OF FEDERAL CLAIMS**

The Board abused its discretion by ignoring a critical fact in its analysis: the United States Court of Federal Claims is not a district court pursuant to Article III of the United States Constitution. Instead, the Court of Federal Claims – much like the Board itself – is a tribunal of limited jurisdiction that is distinct from the subject matter jurisdiction of a district court. See Souders v. South Carolina Public Service Authority, 497 F.3d 1303, 1307 (Fed. Cir. 2007); see also United States v. King, 395 U.S. 1, 2-3 (1969) (noting that the predecessor to the Court of Federal Claims was a court of “limited jurisdiction” relating to “money claims against the United States Government”).

Due to its jurisdictional limitations, the Court of Federal Claims has never considered, and is **jurisdictionally barred** from considering, a trademark infringement suit. See 15 U.S.C. § 1021 (vesting only the “district and territorial courts of the United States” with “original jurisdiction . . . of all actions arising under [the] Act”); Lockridge v. United States, 218 Ct. Cl. 687, 690 (1978) (“We therefore conclude that we have no jurisdiction over claims for trademark infringement.”); Liberty Ammunition, Inc. v. United States, 101 Fed. Cl. 581, 589-92 (2011)

(concluding that the court was barred from exercising pendent jurisdiction over a plaintiff's Lanham Act claim). Similarly, the Court of Federal Claims has never considered, and is **jurisdictionally barred** from reviewing, a decision of the Director or the Trademark Trial and Appeal Board. See 15 U.S.C. §§ 1071(b)(1), (3), (4); Potter v. United States, No. 2015-5089, slip op. at 3 (Fed. Cir. Feb. 29, 2016) ("The Court of Federal Claims was correct in holding that it had no jurisdiction to review the merits of decisions from . . . the Trademark Trial and Appeal Board").

And most significantly to the present Petition, the Court of Federal Claims and the Federal Circuit have both concluded that the Court of Federal Claims lacks jurisdiction to consider a plaintiff's claim to cancel a trademark registration against the United States. In Boyle v. United States, a *pro se* plaintiff sought cancellation of a trademark registration in a suit before the Court of Federal Claims. The court held that it:

does not have general equitable power to issue injunctions in cases other than those in which such power has explicitly been granted. As a result, **this court does not have jurisdiction over plaintiff's claim for [trademark] cancellation or for similar forms of injunctive relief.**

44 Fed. Cl. 60, 65 (1999) (emphasis added). The Federal Circuit expressly agreed with the Court of Federal Claims on this issue in affirming the court's judgment. See Boyle v. United States, 200 F.3d 1369, 1374 (Fed. Cir. 2000) ("The [Court of Federal Claims] properly dismissed Boyle's request for cancellation for lack of jurisdiction.".)<sup>3</sup> Neither the Court of Federal Claims nor the Federal Circuit considered whether the Court of Federal Claims would retain the ability

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<sup>3</sup> The TTAB subsequently noted the decisions when it denied the *pro se* plaintiff's petition to cancel against another entity. See John C. Boyle v. Barclays Global Investors, N.A., 2001 WL 1382014 (TTAB Nov. 1, 2001) (Cancellation No. 29,519).

to defensively order the cancellation of asserted registrations pursuant to Section 1119 of Title 15, and no precedent exists in either forum as to that point.

### III. ON A SIGNIFICANT ISSUE OF FIRST IMPRESSION, THE BOARD'S CURSORY REASONING IS UNSOUND

In light of the significant jurisdictional limitations discussed above, proceedings before the Board and civil actions before the Court of Federal Claims have never before intersected. The Court of Federal Claims has never before considered a substantive trademark issue. The Board has before never considered whether or held that a pending civil action in the Court of Federal Claims has any bearing on a Board proceeding.<sup>4</sup> The present situation presented a unique issue of first impression to the Board – an issue that the Board addressed in a cursory fashion with legally insufficient analysis.

The Board – a tribunal whose jurisdiction over this matter is clearly established by 15 U.S.C. §§ 1064, 1067 – abused its discretion by suggesting that the ownership and invalidity dispute could proceed solely in the Court of Federal Claims – a court of uncertain and untested jurisdiction with respect to those issues. The petition to cancel in this case presented the perfect opportunity for the Board to exercise its statutory authority and “special expertise” in evaluating

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<sup>4</sup> When the NPS raised the jurisdictional question in its opposition to DNCY's motion to suspend, DNCY ignored the question. Compare Response at 9-12 (TTABVUE # 9) with Reply (TTABVUE # 10). Instead, DNCY simply asserted that the ownership and validity issues were not gateway issues because the “legal theories in [the] petition . . . rests [*sic*] entirely and exclusively on the fact that after March, 1, 2016, DNCY was no longer the concessioner at Yosemite National Park.” Reply at 4 (TTABVUE # 10). DNCY's assertion is contradicted by: (1) DNCY's demand for compensation for the alleged future value of the marks after that date; and (2) the NPS's dilution claim, which is not time-bound as characterized by DNCY. Nevertheless, DNCY's flawed assertion also misses the mark with respect to the precise issue before the Board. DNCY does not assert that the Court of Federal Claims will substantively evaluate the ownership and validity issues in a way that would bear upon the Board proceeding; instead, DNCY asserts that the Court of Federal Claims can ignore the ownership and validity issues in a way that would have **no bearing** upon the Board proceeding.

whether the challenged incontestable registrations should be cancelled. Cf. E. & J. Gallo Winery v. F. & P. S.p.A., 899 F. Supp. 465, 468 (E.D. Cal. 1994) (“Though potentially helpful, the TTAB’s special expertise is hardly necessary in federal district courts which regularly adjudicate trademark matters.”). In suspending the proceeding, the Board ignored its expertise and failed to consider whether the Court of Federal Claims is jurisdictionally able to determine ownership to the challenged registrations and order cancellation of the registrations in **this** civil action. The Board’s terse reasoning fails to appreciate that the two legal powers at issue – determining ownership and ordering cancellation – are inexorably linked. If the Court of Federal Claims is barred from ordering cancellation of the Subject Registrations, the Board’s reasoning that “the [Court of Federal Claims] may consider and even reach a determination of ownership rights in the marks at issue” is absolutely contradicted by Section 1115 of Title 15.

Registration confers “significant” legal rights and benefits to trademark owners, B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S.Ct. 1293, 1300 (2015), and the legal rights and benefits for an incontestable registration are truly substantial. In particular, an incontestable registration “shall be **conclusive evidence** of . . . the registrant’s ownership of the mark.” 15 U.S.C. § 1115(b) (emphasis added); see also Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 198 (1985) (“The incontestability provisions . . . provide a means for the registrant to quiet title in the ownership of his mark.”).

Pursuant to Section 1115(b), the Court of Federal Claims cannot “consider and even reach a determination of ownership” of the marks at issue if it is jurisdictionally barred from cancelling the incontestable Subject Registrations. The Board’s unsupported reasoning is fatally flawed in this case if the Court of Federal Claims is jurisdictionally barred from cancelling incontestable registrations that require DNCY to be declared the owner of the disputed marks.



## CONCLUSION

For the foregoing reasons, the NPS respectfully requests that the Director reverse the TTAB's suspension of Cancellation No. 92063225.

Respectfully submitted,

BENJAMIN C. MIZER  
Principal Deputy Assistant Attorney General

June 10, 2016

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CERTIFICATE OF SERVICE

I hereby certify that on June 10, 2016, I mailed the foregoing by depositing a true and correct copy of the same with the United States Postal Service, postage prepaid, in an envelope addressed to DNCY's attorneys of record:

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